

REMARKS

The Office Action rejected claims 1-44 under 35 U.S.C. § 103 as obvious over U.S. patent 5,948,394 ("Walling") in view of U.S. patent 5,093,043 ("Jakobson"). In view of the following comments, Applicant respectfully requests reconsideration and withdrawal of this rejection.

The claimed invention requires the presence of specific compounds having very specific solubility properties and characteristics. The invention requires the presence of (1) an hydrocarbon-based oil which is soluble/dispersible in a volatile hydrocarbon-based solvent; (2) a non-volatile silicone compound which is soluble/dispersible in a volatile hydrocarbon-based solvent; and (3) a hydrocarbon-based oil and a non-volatile silicone compound which are incompatible with each other. Walling neither teaches nor suggests this invention.

Walling generally discloses combining several different types of oils and waxes to form lipstick products. However, this teaching is so general that it provides no guidance whatsoever concerning which oils and waxes could be advantageously combined. As a matter of law, such a general disclosure relating to the theoretical combination of hundreds or thousands of cosmetic ingredients cannot anticipate or render obvious the specific subject matter of the presently claimed invention. See, *In re Meyer*, 599 F.2d 1026 (CCPA 1979); *Akzo v. International Trade Comm'n*, 808 F.2d 1471 (Fed. Cir. 1986).

Walling completely fails to teach, suggest or recognize the importance of combining compounds having the specified solubility relationships set forth in the claims: that is, Walling would not lead one skilled in the art to combine a hydrocarbon-based oil and a

non-volatile silicone compound which are both soluble/dispersible in a volatile hydrocarbon-based solvent yet incompatible with each other. Walling contains no guidance whatsoever to make such a combination.

What's more, Walling discloses that volatile hydrocarbon-based oils and volatile silicone-based oils are interchangeable (col. 4, lines 1-31), thereby failing to recognize any criticality associated with using the required volatile hydrocarbon-based oil.

Clearly, Walling neither teaches nor suggests the claimed invention, and one skilled in the art following Walling's disclosure would not be led to the present invention.

Jakobson does not compensate for Walling's deficiencies. Jakobson is cited only for its disclosure related to diglyceryl diisostearate. Jakobson neither teaches, suggests, nor recognizes the importance of combining a hydrocarbon-based oil and a non-volatile silicone compound which are both soluble/dispersible in a volatile hydrocarbon-based solvent yet incompatible with each other.

In view of the above, Applicant respectfully requests reconsideration and withdrawal of the § 103 rejection.


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Applicants believe that the present application is in condition for allowance.

Prompt and favorable consideration is earnestly solicited.

Respectfully submitted,

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